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Docket No.: 6954.035.00-US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
J. K. Kelly, et al.

Application No.: 09/373,576

Filed: August 13, 1999

For: GARDEN AND AGRICULTURAL
MATERIAL IDENTIFICATION METHOD
AND APPARATUS

Confirmation No.: 2727

Customer No.: 30827

Group Art Unit: 3625

Examiner: Y. Garg

REPLY BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Dear Sir:

In response to the Examiner's Answer mailed August 6, 2004, Appellants submit the following Reply Brief in the above-identified application (transmitted in triplicate):

ARGUMENTS

Further to the arguments made in the Appeal Brief filed on May 6, 2004 and the Supplemental Appeal Brief filed on July 20, 2004, and in reply to the Examiner's Answer dated August 6, 2004, Appellants assert that all pending claims are patentable over the cited references.

At page 8 of the Examiner's Answer ("Answer"), the Examiner indicates that Sullivan et al. describes the use of the diagnostic map which executes on the client machine as the "preferred embodiment." Beginning at page 9 of the Answer, the Examiner cites *In re Wiseman*, 201 USPQ 658 (CCPA 1979); *In re Shepard*, 138 USPQ 148 (CCPA 1963); *In re Bozek*, 163 USPQ 545 (CCPA 1969); *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CAFC 1989); and *In re Boe*, 148 USPQ 507 (CCPA 1966) and concludes "the examiner should consider the total broader disclosure rather than confining to preferred

embodiments/teachings of the disclosure.” The Examiner then relies upon the subject matter disclosed at column 1, lines 38-55 and at column 2, lines 44-55 of Sullivan et al. as generically disclosing “technical customer support centers for solving the problems of [a] customer via an interactive communication network” that are allegedly combinable with Gerland et al. to obviate the claimed invention. These two sections will be separately discussed below.

The Examiner relies upon column 2, lines 44-55 of Sullivan et al. as generically disclosing “receiving a request from a user for help and the user is prompted to select a general problem area and also provided with interactive interface to respond to his queries.” The Examiner then concludes “[s]uch client-server architectures are adaptable in providing customer support irrespective of the type of products and services, that is this architecture would allow customers to send queries related to gardening problems....” Appellants respectfully disagree.

Notwithstanding the cases cited above (i.e., *In re Wiseman, et seq.*) a reference must still be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert denied*, 469 U.S. 851 (1984). Thus, distilling an invention down to the “gist” or “thrust” of an invention disregards the requirement of analyzing the subject matter “as a whole.” *Id.*

While Sullivan et al. superficially describes use of the diagnostic map executed on the client machine as the “preferred embodiment,” this is the only embodiment described that discusses how a search string is formulated. Moreover, column 2, lines 44-55 of Sullivan et al. does not constitute another embodiment of the inventive concept of Sullivan et al. but, rather, constitutes a fragment of the BRIEF SUMMARY OF THE INVENTION summarizing the subject matter included within the DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT. Specifically, at column 2, lines 49-52 Sullivan et al. teaches that, when the a user desires technical support, “[t]he user is prompted to select a general problem area. In response to a user query, the system automatically serves a self-help home page... to the user’s interface.” Further, at column 2, line 56 - column 3, line 1, Sullivan et al. teaches:

“the self-help home page includes a search field that is populated automatically with a system-supplied, self-help search string. This function obviates the user having to make a set of guesses about the precise search string

or strings that will direct the user to the right support solution(s). The search string is a value that, when fed into the technical support server's search engine, should produce relevant hits. In the preferred embodiment, the search string is generated dynamically through the use of a diagnostic map that executes on the client machine when the self-help session is initiated. The diagnostic map examines the client system (including the existing applications, registry information and the like) and communicates with the technical support server to derive the search string as a background task."

Assuming *arguendo* that column 2, lines 44-55 of Sullivan et al. may be interpreted as teaching "receiving a request from a user for help," prompting "the user... to select a general problem area" and providing the user "with interactive [an] interface to respond to his queries," such an interpretation is impermissible within the context of formulating the present obviousness-based rejection as it not only constitutes a generalized, distilled summary of the invention described by Sullivan et al., but also constitutes a fragment of the invention described by Sullivan et al. When read as a whole, and for reasons discussed in the Appellants' Brief, problems solved by Sullivan et al. must be existent on a user's computer. Therefore, it is respectfully submitted that Sullivan et al. actually teaches away from the Examiner's aforementioned generalization and, consequently, away from the present invention. To modify the inventive concept of Sullivan et al. as suggested by the Examiner, enabling it to solve problems that do not exist on a user's computer, would not only render the Sullivan et al. unsatisfactory for its intended purpose, *see In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), but would impermissibly change the principle operation of Sullivan et al., *see In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In view of the discussion above, Appellants submit that the client-server architecture discussed in Sullivan et al. is not "adaptable in providing customer support irrespective of the type of products or services" and would not "allow customers to send queries related to gardening problems," as asserted by the Examiner. For at least these reasons, Appellants respectfully submit that the present invention is patentable over the cited references.

The Examiner relies upon column 1, lines 38-55 of Sullivan et al. as generically teaching "architectures, as admitted prior art, [that] do not require that problems... [to] be existent on the actual user's computer but are adaptable to support customers in solving their problems by diagnosing them and offering solutions."

Preliminarily, Appellants submit reliance on column 1, lines 38-55 of Sullivan et al. not only constitutes a change in evidence relied upon to support the final rejection, but also changes the basic thrust of the final rejection, denying Appellants a fair opportunity to react to this new theory supporting the present rejection. Consequently, Appellants respectfully request that prosecution be reopened and finality of the present rejection be withdrawn. See 37 C.F.R. § 1.193(a)(2).

At section 10 (i.e., the "Grounds of Rejection" section) of the Answer, the rejection of claims 1, 2, 4, 8-11, 13-15, 21-24, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Sullivan et al. in view of Gerland et al. and National Gardening is reiterated. In this rejection, specific reliance is made upon subject matter illustrated in Figures 1-12 and disclosed in column 2, line 44-column 3, line 60; column 4, line 55-column 8, line 47; and column 11, lines 22-58, of Sullivan et al. This subject matter is directed solely to the inventive concepts of which Sullivan et al. is concerned. Accordingly, the theory upon which the final rejection is predicated consists solely of motivations why one of ordinary skill in the art would modify the inventive concept of Sullivan et al. using Gerland et al. and National Gardening and arrive at the present invention. However, at section 11 (i.e., the "Response to Argument" section) of the Answer, the Examiner relies, for the first time, upon the teachings in the "Description of the Related Art" section of Sullivan et al. (i.e., subject matter found at column 1, lines 38-55 of Sullivan et al.) to explain why one of ordinary skill in the art would modify non-inventive, previously known concepts mentioned in Sullivan et al. using Gerland et al. and National Gardening and arrive at the present invention. Consequently, Appellants respectfully request that prosecution be reopened and finality of the present rejection be withdrawn.

Even if arguments made in the "Response to Argument" section of the Examiner's Answer do not constitute new grounds of rejection, Appellants respectfully submit that column 1, lines 38-55 fails to teach the elements recited in the claims that the inventive concept of Sullivan et al. was relied upon as allegedly teaching. For at least this reason, Appellants respectfully request withdrawal of the present rejection.

At page 11 of the Answer, the Examiner states that the "motivation to modify Sullivan et al. to incorporate Gerland's teaching was that Sullivan's architecture could be

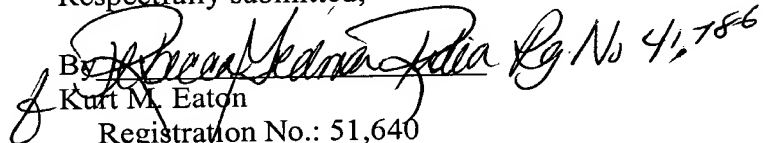
modified to resolve gardening problems of the users... Sullivan's architecture... would allow users to access a web site dealing with gardening matter... and the server at the web site could prompt the user to select a problem area and provide answers." As set forth at M.P.E.P. § 2143.01, however, the mere fact that references can be combined, or that the claimed invention is within the capabilities of one of ordinary skill in the art, is insufficient to establish *prima facie* case of obviousness. *See also In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In view of the above arguments, Appellants respectfully request that the Board of Patent Appeals and Interferences dismiss the Examiner's rejections and allow claims 1-16 and 18-30.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911. A duplicate copy of this sheet is enclosed.

Dated: October 8, 2004

Respectfully submitted,

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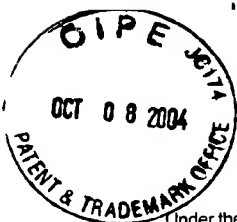
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		Art Unit	3625
		Examiner Name	Y. C. Garg
Total Number of Pages in This Submission	6	Attorney Docket Number	6945.035.00

ENCLOSURES (Check all that apply)

<input type="checkbox"/> Amendment Transmittal Letter <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Response to Election of Species Requirement <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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Date	October 8, 2004